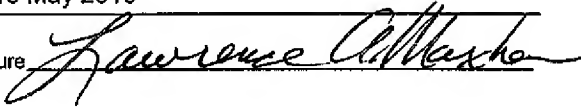



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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		740-071	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>13 May 2010</u></p> <p>Signature <u></u></p> <p>Typed or printed name <u>Lawrence A. Maxham</u></p>		Application Number	Filed
		10/530,070	2005-08-29
		First Named Inventor	
		Deitmar MÜLLER	
		Art Unit	Examiner
		2618	Andrew WENDELL
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>24,483</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>		<p><u></u> Signature</p> <p><u>Lawrence A. Maxham</u> Typed or printed name</p> <p><u>(858) 587-7659</u> Telephone number</p> <p><u>13 May 2010</u> Date</p>	
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## ARGUMENTS FOR PRE-APPEAL BRIEF REQUEST

The Examiner has erred in rejecting claims 9-16 and 22-33 under 35 U.S.C. 102(e) as being anticipated by Wilson et al. because Wilson does not disclose the feature of permitting a mobile telecommunications terminal device to be connected to only defined destination or source addresses, or both, as required by independent claims 9 and 33. Independent claims 9 and 33 are set forth on the last page of this paper.

Claim 9 recites, in part, a SIM card for operation with a terminal device of a mobile telecommunication network;

“wherein the SIM card is configured in such a manner that with the SIM card the terminal device can be connected to only defined destination or source addresses, or both.”

Claims 10-16 and 22-32 depend from Claim 9.

Claim 33 recites, in part, a process of limiting use of a mobile telecommunications terminal device, the process comprising:

“in the terminal device using a SIM card that permits connections only to defined destination or source addresses, or both.”

Wilson merely discloses permitting only selected friends of a user of a mobile telecommunications terminal device to learn the location of the user’s mobile terminal device, wherein a user of a mobile terminal device can add a mobile number (address) of a friend to a list of friends in a SIM card of his mobile device to thereby permit (or deny) the friend to learn the location of the user’s mobile device.

In paragraph 0129, Wilson disclose the use of a SIM card in a mobile terminal device for storing a first list of the device user’s friends who may receive via a telecommunication network, a current location of the user's device; a second list of the user’s friends who have permitted the user’s device to receive, via the network, the

respective locations of wireless devices associated with the user's friends; and a third "deny always" list of friends to whom the user wishes to always deny his or her location. See also paragraphs 37-38 and 151, and claims 1 and 32 of Wilson.

5           The **issue** is whether claims 9 and 33 can be reasonably construed so broadly as to read on the disclosure of Wilson.

10           The Court of Appeals for the Federal Circuit recently reiterated that in giving claims their "broadest reasonable construction," such construction must be consistent with the specification (*In Re Suitco Surface, Inc.*, Case No. 2009-1418 (Fed. Cir. 2010)). The court stated, "claims should always be read in light of the specification and the teachings in the underlying patent."

15           The specification of the present application discloses permitting a mobile terminal device to be connected to only defined destination or source addresses, or both, as required by claims 9 and 33. This clearly does not encompass permitting only selected friends of a user of a mobile terminal device to learn the location of the user's mobile terminal device, as disclosed by Wilson. Therefore, Wilson cannot properly be a basis for rejecting the pending claims because the broadest reasonable construction in light of the specification and  
20    teachings of the underlying application do not encompass what Wilson discloses.

          Permitting only selected friends of a user of a mobile terminal device to learn the location of the user's mobile terminal device is not consistent with permitting a mobile terminal device to be connected to only defined destination or source addresses, or both.  
25    Learning the *location* of a mobile terminal device is not equivalent to being *connected* to a mobile terminal device.

          Therefore, it is not reasonable to construe claims 9 and 33 so broadly as to read on the disclosure of Wilson.

30

The Examiner also erred in rejecting claims 17-21 under 35 U.S.C. 103(a) as being unpatentable over Wilson in view of Lipsanen et al. because, inter alia, claims 17-21 depend from claim 9 and Lipsanen does not contain any disclosure that is relevant to the limitations of claim 9 that are discussed above.

5

The Examiner further erred in rejecting claims 34 and 35 under 35 U.S.C. 103(a) as being unpatentable over Wilson in view of Zabawskyj et al. because, inter alia, claims 34 and 35 respectively depend from claims 33 and 9 and Zabawskyj does not contain any disclosure that is relevant to the limitations of claims 33 and 9 that are discussed above.

10

#### **The Independent Claims at Issue**

9. A SIM card for operation with a terminal device of a mobile telecommunication network;

15 wherein the SIM card is configured in such a manner that with the SIM card the terminal device can be connected to only defined destination or source addresses, or both; and

wherein the defined destination and source addresses to which the terminal device can be connected are stored in a memory of the SIM card or in a database of the mobile telecommunication network.

20

33. A process of limiting use of a mobile telecommunications terminal device, the process comprising:

in the terminal device using a SIM card that permits connections only to defined destination or source addresses, or both;

25 wherein the defined destination and source addresses to which the terminal device can be connected are stored in a memory of the SIM card or in a database of a mobile communication network.